



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,762	03/28/2000	Akio Yamanishi	44319-051	5310

20277 7590 06/19/2002
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

KREMER, MATTHEW J

ART UNIT	PAPER NUMBER
----------	--------------

3736

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/536,762	YAMANISHI, AKIO
	Examiner	Art Unit
	Matthew J Kremer	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 April 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 3 is/are allowed.

6) Claim(s) 1-10 and 12 is/are rejected.

7) Claim(s) 11 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,830,132 to Robinson. Robinson discloses a method and apparatus for determining one or more concentrations of an analyte in human tissue. (Abstract of Robinson). Bilirubin can be determined (column 1, lines 8-15). In the Abstract, Robinson teaches that the method includes irradiating the tissue at several wavelengths so that there is differential absorption of some of the wavelengths by the tissue as a function of the wavelengths and the known analyte. In column 26, lines 29-49, Robinson discloses an illustration of a finger sampling device which utilizes a single

broadband source which is transmitted through a wavelength separating device as seen in Fig. 35. Device 801 includes a wavelength separating device 817 which is an acousto-optic tunable filter that is coupled to base 803 via light pipe 819. The specific wavelength that is emitted from device 817 is transmitted through the finger 11. After transmission through the finger 11, the light at the selected wavelength is then detected by detector rings 831, 833 and 835. It is well known in the art that detectors generate signals that correspond to an intensity of the incident light. The wavelength is changed and another specific wavelength is transmitted through the finger and the process is repeated until all desired wavelengths are transmitted. The signals are processed to calculate the concentration of the analyte (column 23, line 59 to column 24, lines 12). In regard to claim 2, Fig. 36 shows a circular emerging port 817, a first light incident port 831, a second light incident port 833, and a third light incident port 835.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,132 to Robinson as applied to claim 1 above. In regard to claims 4, Robinson does not teach a first light splitter and a second light splitter. Robinson does

teach an embodiment of the invention in which an acousto-optic tunable filter (AOTF) controls the light received by the detector (column 22, line 33 to column 24, lines 27 of Robinson). Robinson teaches that several instrument configurations can be used. (column 22, lines 48-52). It is well known in the art that light splitters are functionally equivalent to the AOTF configuration of Robinson. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute multiple beam splitters for the AOTF configuration of Robinson since they are functionally equivalent and Robinson states that several instrument configurations can be used. In regard to claims 6, the acousto-optic tunable filter (AOTF) controls the emission of the broadband source. Robinson further teaches that a discrete number of LEDs such as 20 can be used (column 17, lines 61-65) instead of broadband sources. This suggests that multiple LEDs are functionally equivalent to broadband sources. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the multiple LEDs for the broadband source as disclosed by Robinson since they are functionally equivalent and it has generally been held to be within the skill level of the art to substitute elements that are functionally equivalent. It is well known in the art that LEDs can be switched in sequence to control the emission of the wavelengths being transmitted into the tissue that would be functionally equivalent to the AOTF controls. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the sequencing of the LEDs for the AOTF controls since they are functionally equivalent and it has generally been held to be within the skill level of the art to substitute elements

Art Unit: 3736

that are functionally equivalent. In regard to claim 7, Fig. 35 shows channels in finger support surface 805 that act as light guiding members to detector rings 831, 833, and 835. In regard to claim 8, Robinson teaches that the wavelength region of interest will be 300-1000 nm for bilirubin which covers the entire visible spectrum. (column 27, lines 6-20 of Robinson). Robinson further teaches that there is a significant absorption peak at 454 nm (blue wavelength) for bilirubin. Robinson also teaches that a discrete number of LEDs such as 20 can be used (column 17, lines 61-65). Using 20 LEDs over the span of 300-1000 nm, the result would be center wavelengths every 35 nm. Using 454 nm for the one wavelength as recommended by Robinson and using 35 nm increments, it would be obvious the other wavelengths would be 314, 349, 384, 419, 454, 489, 524, 559, 594, 629, 664, 699, 734, 769, 804, 839, 874, 909, 944, and 979. These wavelengths include: three red wavelengths (664, 699, 734), two blue wavelengths (454, 489), and two green wavelengths (524, 559). In regard to claim 9, it is known in the art that for bilirubin, there is high absorptivity at 450 nm and low absorptivity around 560 nm (U.S. Patent 5,791,345 to Ishihara et al.). Robinson explicitly states that 454 nm should be used which has high absorptivity. The combination includes 559 nm which inherently has low absorptivity.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,132 to Robinson as applied to claim 1 above, and further in view of U.S. Patent 5,879,294 to Anderson et al. Robinson does not teach calculating 1-4 products by multiplying 1-4 constants by 1-4 electrical signals, a calculation of the logarithmic

Art Unit: 3736

number of a quotient obtained by division of the second product by the first product, a calculation of a logarithmic number of a quotient obtained by division of the fourth product by the third produce, and calculation of a bilirubin concentration based on the difference. Robinson does teach that quantitative analysis of the processed spectra is performed by a central processing unit in conjunction with a multivariate calibration model and algorithms and the results are in a memory storage unit. (column 24, lines 1-12 of Robinson). It is well known in the art that the steps for processing signals includes using an empirically determined absorption coefficient which is multiplied by the optical absorption value to help determine the analyte concentration. (column 1, lines 36-48 of Anderson). Anderson further discloses that ratios of absorption of measuring and reference wavelengths are used for normalizing which is used to remove some effects of noise. Anderson further teaches that an alternative mathematical model involves determining an analyte concentration by taking the logarithmic value of the measured spectral values. (column 20, line 46 to column 21, line 8 of Anderson). These analyzing techniques as disclosed by Anderson are well known in the art and serve the function to analyze spectra data that is required in Robinson. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method and apparatus of Robinson to include the analyzing techniques of Anderson since Robinson requires spectral analysis to be performed and Anderson teaches well known techniques for implementing the analysis. The combination of these techniques in which the most appropriate order of analysis can be determined by routine experimentation would, therefore, be *prima facie* obvious to one having ordinary

Art Unit: 3736

skill in the art. The product between constants and signals are obvious depending on the calibration data. The ratio between the measurement wavelengths and reference wavelength at one distance and the ratio between the measurement wavelengths and reference wavelengths at the second and third distances are obvious since the normalization will help remove errors due to noise. It is known in the art that the reference wavelength for the ratio is a wavelength in which there is low absorption which includes 560 nm for bilirubin as stated in the previous paragraph. It is obvious to use the transformation using logarithms to determine the analyte measurement from the normalized spectral data. It would be also obvious to use the multivariate analysis to correlate the logarithmic values to a final measurement.

Response to Arguments

6. Applicant's arguments filed 4/12/2002 have been fully considered but they are not persuasive. Applicant argues that Robinson teaches that measurements are carried out a plurality of times by changing the wavelength to obtain data. Applicant further argues that the instant application teaches that the light emitter emits light only once which differs from Robinson in that Robinson teaches that the light emitter emits light a plurality of times. The Examiner respectfully disagrees. First, Robinson teaches that the light is emitted only once. Robinson discloses that a single broadband source is transmitted through a wavelength separating device. (column 26, lines 29-49 of Robinson) . The AOTF changes the wavelengths but the broadband source remains on during the wavelength separation. In other words, the light emitter is emitting light only

once and the AOTF is separating the wavelengths at different times. Therefore, Robinson meets the limitations as set forth in claim 1 of the present application. In response to the Applicants argument that Robinson teaches that the measurement is carried out at a plurality of times, it is noted that the feature upon which applicant relies (i.e., the measurements are taken simultaneously) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since the rejections of independent claim 1 is deemed proper due to the reasons stated above and the applicant provides no other arguments, the rejection of the subsequent dependent claims are also maintained.

Allowable Subject Matter

7. Claim 3 is allowed.

8. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,297,554 to Glynn et al. teaches a device that uses spectrophotometric analysis of the retina to determine bilirubin. The device uses a series of concentric rings with alternate fibres in each ring directing light towards the eye and detecting light reflected therefrom.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 703-605-0421. The examiner can normally be reached on Mon. through Fri. between 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Winakur can be reached on 703-308-3940. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Matthew Kremer
Assistant Examiner
Art Unit 3736
June 13, 2002



KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700
6/19/02